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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,849	02/06/2004	Masami Tsuruta	CTW-028	7173
959	7590	05/03/2005		
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			EXAMINER LEE, Y MY QUACH	
			ART UNIT 2875	PAPER NUMBER

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/773,849

Applicant(s)

TSURUTA ET AL.

Examiner

Y Quach Lee

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-12 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/6/04 &amp; 8/9/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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### ***DETAILED ACTION***

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature of "switch lever" as claimed in claims 7 and 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Specification***

3. The disclosure is objected to because of the following informalities: The reference numeral "1" is represented by two separate elements, "an impact driver" on line 29 of page 3 and lines 1, 16, 27, 32 and 35 of page 4 as well as "the electric power tool" on line 38 of page 3 and line 4 of page 4. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Pemberton.

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Pemberton shows a light source (20) capable of emitting light, at least one component (10) at least part of which is self-luminous, the component capable of storing at least part of the light emitted from the light source and emitting light, the self-luminous component directly exposed to the light emitted from the light source, and wherein the component is provided with self-luminous characteristics by mixing of at least one self-luminous material (60) therein during the manufacturing of the component (column 3, lines 11 to 14 and 27 to 31). Note that the recitation "An electric power tool" has not been given patentable weight because the recitation occurs in the preamble and the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 6 and 8 to 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa (JP 138269, prior art cited by applicant) in view of Horiyama et al.

Hayakawa discloses an electric power tool comprised of at least one component at least part of which is self-luminous with the component capable of storing at least part of the light emitted from light source and emitting light, the self-luminous component provided with self-luminous characteristics disposed on the part of the power tool such as the components (2, 8 ...) operated by a user, the self luminous component also consisting of the attachments (4) to the power tool, and the self-luminous component provided with self-luminous characteristics by coating of at least one self-luminous material thereon or by mixing of at least one self-luminous material therein during the manufacturing of the component. However, Hayakawa does not disclose that the self-luminous component directly exposed to the light emitted from a light source and irradiated by the light source.

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Horiyama et al. teach a flexible light source (26) coupled to an electric power tool. This flexible light source can be manually adjusted to illuminate different directions of and around the power tool including any objects located in front of the tool bit.

It would have been obvious to one skilled in the art to provide the power tool of Hayakawa with a flexible light source, as shown by Horiyama et al., so that not only any objects located in front of the tool bit or different directions of and around the power tool can be illuminated but the self-luminous component can also be charged, while using the power tool by directly exposing the self-luminous component to the light emitted from the light source, for self illuminating at a later time during poorly illuminated environment.

8. Claims 1 to 4 and 6 to 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiyama et al. in view of Hayakawa (JP 138269, prior art cited by applicant).

Horiyama et al. disclose an electric power tool comprised of a flexible light source (26) capable of emitting light, a main housing (46) coupled to a rear end of a gear housing, the light source disposed at a front end of the main housing on an underside of the gear housing (figure 7), an annular component (47) mounted around a front end of the gear housing immediately forward of the light source, an on/off trigger (49), a switch lever (28), a battery pack (31), a hook (76) for hanging the power tool on a structure, and at least one bit (figure 7). However, Horiyama et al. do not disclose at least one component provided with self-luminous characteristics disposed on the part of the power tool selected from the components operated by a user or attachments to the power tool such as on/off trigger or an annular shape component mounted around a front end of the gear housing, and the self-luminous characteristics provided by coating of at least one self-luminous material on the component or by mixing at least one self-luminous material in the component during the manufacturing of the component.

Hayakawa teaches at least one component at least part of which is self-luminous with the component capable of storing at least part of the light emitted from light source and emitting light, the self-luminous component provided with self-luminous characteristics disposed on the part of the power tool such as the components (2, 8 ...) operated by a user, the self luminous component also consisting of the attachments (4) to the power tool and an annular shape component (10) mounted around a front end of the gear housing, and the self-luminous

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component provided with self-luminous characteristics by coating of at least one self-luminous material on the component or by mixing of at least one self-luminous material in the component during the manufacturing of the component.

It would have been obvious to one skilled in the art to provide the part of the power tool of Horiyama et al. such as the components operated by a user such as on/off trigger, the annual shape component mounted around a front end of the gear housing, and/or the attachments to the power tool with self-luminous characteristics by coating of at least one self-luminous material thereon or by mixing of at least one self-luminous material therein, as shown by Hayakawa, so that the components on the part of the power tool can be charged by the light emitted from the light source while using the power tool in order for the components of the power tool to be self-illuminated at a later time during poorly illuminated environment for preventing the power tool from being left out of the specific place.

9. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

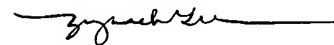
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Southworth is cited to show another pertinent electric power tool.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is 571-272-2815.

Y. Q.  
April 21, 2005

  
Y Quach Lee  
Patent Examiner  
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